

REMARKS

Claims 1-18 are currently pending in the Application. Claim 17 is currently amended to clarify the subject matter of the claimed invention, without acquiescence in the cited basis for rejection or prejudice to pursue the original claim in a related application. Claims 19-20 are new. No new matter has been added.

I. Rejections of the Claims under 35 U.S.C. § 112, First Paragraph

Claims 5-7 and 9-12 stand rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement. Applicants respectfully traverse.

A. Applicants respectfully submit that the standard for determining whether the specification meets the enablement requirement is whether “the experimentation needed to practice the invention undue or unreasonable”. MPEP § 2164.01 citing *Mineral Separation v. Hyde*, 242 U.S. 261, 270 (1916). MPEP further mandates that “even though the statute does not use the term ‘undue experimentation’, it has been interpreted to require that the claimed invention be enabled so that any person skilled in the art can make and use the invention without undue experimentation.” MPEP § 2164.01 citing *In re Wands*, 858 F.2d at 737, 8 USPQ2d at 1414 (Fed. Cir. 1988).

In addition, Applicants respectfully submit that MPEP 2164.01(a) explicitly mandates that “[i]t is **improper** to conclude that a disclosure is not enabling based on an **analysis of only one of the above factors while ignoring one or more of the others**.” The same section of MPEP further lists the eight factors that the Court of Appeals for the Federal Circuit requires in determining whether any necessary experimentation is undue. These factors include (A) the breadth of the claims; (B) the nature of the invention; (C) the state of the prior art; (D) the level of one of ordinary skill; (E) the level of predictability in the art; (F) the amount of direction provided by the inventor; (G) the existence of working examples; and (H) the quantity of experimentation needed to make or use the invention based on the content of the disclosure.

Applicants respectfully submit that the final Office action did not analyze any of the above eight factors but just summarily concluded that “[t]he claim(s) contains subject matter which was not described in the Specification in such a way as to enable one skilled in the art to which it pertains, or

with which it is most nearly connected, to make and / or use the invention.” The final Office action then concludes that “[o]ne reasonably skilled in the art could not make or use the invention from the disclosure in the specification, coupled with information known in the art, without undue experimentation.” Although the final Office action provides some reasons by citing to some passages in the Application, Applicants respectfully submit that these passages merely represent one or some embodiments of the invention and shall not be read into the claims to limit the scope of the claims. Applicants further respectfully submit that although the final Office action provides some reasons for the rejections under 35 U.S.C. § 112, first paragraph, which Applicants respectfully traverse, the final Office action **fails to consider the eight factors required by the Federal Circuit and MPEP.**

Therefore, Applicants respectfully submit that the ground for rejection of claims 4-7 and 28-30 under 35 U.S.C. § 112, first paragraph, for failure to meet the enablement requirement may be improper. Applicants thus respectfully request withdrawal of the rejections and reconsideration of these claims.

B. The final Office action cites to Fig. 4 and its corresponding pp. 21-22 to support the basis for the enablement rejection of claims 5-7 and 9-12 under 35 U.S.C. § 112, first paragraph.

Applicants respectfully submit that “[l]imitations appearing in the specification but not recited in the claim should not be read into the claims.” MPEP § 2106 citing *E-Pass Techs., Inc. v. 3Com Corp.*, 343 F.3d 1364, 1369, 67 USPQ2d 1947, 1950 (Fed. Cir. 2003). Applicants respectfully submit that Fig. 4 and pp. 21-22 merely represent one or some embodiments of the invention and thus should not be read into the claims.

C. In addition, Applicants respectfully point to several examples in the Specification which provide clear written description to enable one of ordinary skill in the art to make and use the claimed invention without undue experimentation. Applicants further respectfully note that the following examples are provided for illustration and explanation purposes only.

Applicants first respectfully point to *p. 3, l. 20-p. 4, l. 6* which provides, as some background information and to the extent pertinent, that “[t]he value ‘Z’, however, does not represent a state of either 0 or 1. The value ‘Z’ . . . represents the state of a signal not being driven or floating . . .

When not actively driving a signal, an electronic device . . . may present a high-impedance state, or ‘Z’ state, at its output. . . .”

Applicants then respectfully point to *p. 13, ll. 10-16* which illustrate some embodiments of the claimed invention. These passages show that when an analog circuit block receives a Z value (i.e., floating value) of an input (i.e., the input is not being driven), simulator 100 enables the **analog** circuit block to **solve for that node as if it were an output of the analog block**. *P. 19, l. 18-p. 20, l. 7* further illustrates that, in some embodiments, when an input to analog block 203 is a Z value, then such an input to analog circuit block 203 is not being driven by another device or circuit (). In this case, simulator 100 solves for the analog circuit block 203 absent the input to analog block 203 and propagates the analog block solution (i.e., signal value) to other fanouts of net 202 **using the output portion of the analog input**. These passages clearly provide sufficient written description to enable one of ordinary skill in the art to make and use the claimed invention as encompassed in claim 5 which, in part, recites “simulating the circuit design by modeling at least one of said output . . . **as an analog output signal** from said analog circuit to said node when said at least one of said output is **in said high impedance state**” (emphasis added.)

In addition, Applicants respectfully point to *p. 12, l. 16-p. 13, l. 9* which states, to the extent pertinent, “when digital gate 201 drives any non-Z value onto network node 202, every fanout of net 202 including analog circuit block 203 connected to net 202 (analog block 203 in this example includes, among other things, components R1/R2 and transistor devices M1/M2) receive this non-Z value as an input. However, when digital gate 201 is not driving an output signal of 0, 1, or X, digital gate 201 presents a Z value (i.e., floating) output onto net 202” That is, when the digital gate 201 drives any non-Z value (i.e., not floating or not in high impedance state), every fanout of net 202 including analog circuit block 203 **receives this non-Z value as an input rather than an output** as illustrated in the preceding paragraph immediately above when the digital circuit block is not driving any non-Z values. Applicants therefore respectfully submit that these exemplary paragraphs clearly provide sufficient written description for the claimed invention of the independent claim 5 which recites, to the extent pertinent, “simulating the circuit design by modeling at least one of said output **as a digital output signal** from the corresponding digital circuit to said node when said at least one of said output is **not in said high impedance state**” (emphasis added.)

Therefore, Applicants respectfully submit that since claim 9 recites similar limitations as does claim 5, and claims 6-7 and 10-12 depend from claims 5 and 9 respectively, claim 5-7 and 9-12 are believed to have satisfied the requirements under 35 U.S.C. § 112, first paragraph. Applicants thus respectfully request the withdrawal of the rejections and reconsideration of these claims.

II. New Claims

Applicants respectfully submit that new claims 19-20 are also believed to be allowable due to at least their dependency upon the allowable base claims.

III. Allowable Subject Matter

Applicants would like to thank the Examiner for finding claims 1-18 to be allowable over the prior art of record.

CONCLUSION

Based on the foregoing, all claims are believed allowable, and an allowance of the claims is respectfully requested. If the Examiner has any questions or comments, the Examiner is respectfully requested to contact the undersigned at the number listed below.

Applicant(s) hereby explicitly retracts and rescinds any and all of the arguments and disclaimers presented to distinguish the prior art of record during the prosecution of all parent and related application(s)/patent(s), and respectfully requests that the Examiner re-visit the prior art that such arguments and disclaimers were made to avoid.

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Respectfully submitted,

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